



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RESUBMISSION OF REQUEST FOR WITHDRAWAL OF JUNE 15, 2004
OFFICE ACTION

APPLICANTS: Gunnar Magnusson GROUP ART UNIT: 3762
5 SERIAL NO.: 09/914,248 EXAMINER: Mark Bockelman
FILED: August 24, 2001 CONFIRMATION NO.: 2023
TITLE: "IMPLANTABLE TISSUE STIMULATING DEVICE"

MAIL STOP AMENDMENT

Commissioner for Patents

10 P.O. Box 1450
Alexandria, Virginia 22313-1450

SIR:

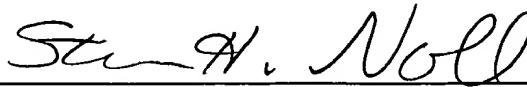
On August 16, 2004, Applicant filed a Request for Withdrawal of June 15, 2004 Office Action. A copy of the Request for Withdrawal of June 15, 15 2004 Office Action is attached hereto, together with a copy of the return postcard indicating receipt thereof on August 16, 2004 at the Patent and Trademark Office.

The reason for submitting the aforementioned Request was that an Office Action dated June 15, 2004 was rendered that acted on the original 20 PCT claims of this application, however, an Amendment "A" Prior to Action cancelling those claims, and substituting a new set of claims, was filed with the original PCT application. The aforementioned Request provided a copy of Amendment "A" Prior to Action as well as a copy of the postcard indicating receipt thereof at the Patent and Trademark Office. Copies of those items are 25 again attached hereto.

Despite numerous telephone calls to the Examiner, the undersigned counsel has not been able to receive any confirmation that these documents have been received and processed at the Patent and Trademark Office. The last item indicated in the PAIR printout is the Non-Final Rejection dated June 30 15, 2004. Since the end of the sixth month period for response expires as of the date of mailing of this Resubmission, Applicants are again requesting

withdrawal of the June 15, 2004 Office Action, in order to avoid abandonment of the present application.

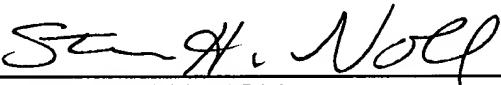
Submitted by,

 (Reg. 28,982)

5 SCHIFF, HARDIN LLP
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Patent Department
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Telephone: 312/258-5790
10 Attorneys for Applicant

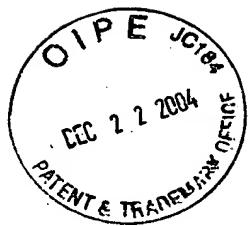
CERTIFICATE OF MAILING

15 I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on December 15, 2004.



20 STEVEN H. NOLL

CH1\4207548.1



ON. COMMISSIONER OF PATENTS
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450

SIR:
PLEASE APPLY A RECEIPT STAMP HERETO AND MAIL TO
ACKNOWLEDGE RECEIPT OF THE ATTACHED:

REQUEST FOR WITHDRAWAL OF JUNE
15, 2004 OFFICE ACTION – 2 pages –
Copy of stamped postcard – Copy of
Amendment "A" Prior To Action

Gunnar Magnusson

APPLICANT

TYPE OF DOCUMENT(S)

August 9, 2004

MAILING DATE

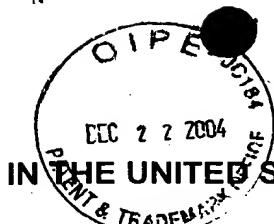
USSN 09/914,248 P01,0292

REFERENCE NUMBER

9/15/04

27009-0102 SHN

SCHIFF HARDIN & WaITE



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REQUEST FOR WITHDRAWAL OF JUNE 15, 2004 OFFICE ACTION

APPLICANTS: Gunnar MAGNUSSON GROUP ART UNIT: 3762
SERIAL NO.: 09/914,248 EXAMINER: Mark Bockelman
5 FILED: August 24, 2001 CONFIRMATION NO.: 2023
TITLE: "IMPLANTABLE TISSUE STIMULATING DEVICE"

10 Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

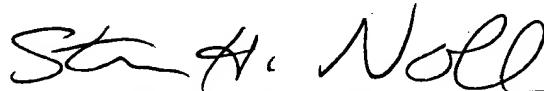
Sir:

15 An Office Action was mailed in connection with the above-referenced application on June 15, 2004, wherein claims 1-13 were acted upon. Claims 1-13, however, have been cancelled in Amendment "A" Prior to Action, that was filed with the original application at the time of entry into the national examination phase in the United States. A copy of Amendment "A" Prior To 20 Action together with a copy of the stamped return postcard indicating receipt thereof at the Patent and Trademark Office is submitted herewith.

This has become an increasingly common problem in connection with PCT applications and the scanning procedure that is now in place in the Patent and Trademark Office. It is frequently the case that not all papers 25 accompanying the filing of a PCT application are scanned into the electronic file at the Patent and Trademark Office, and therefore the Examiner has no idea that an Amendment has been filed.

Withdrawal of the Office Action dated June 25, 2004 is therefore respectfully requested, as is action on the merits with regard to claims 14-26.

Submitted by,



(Reg. 28,982)

5

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10

CERTIFICATE OF MAILING

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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on August 10, 2004.

20


STEVEN H. NOLL

CH1\4170480.1

Express Mail EL 843729411 US
HON: COMMISSIONER OF PATENTS & TRADEMARKS
SHINGTON, D.C. 20231

SIR:

PLEASE APPLY A RECEIPT STAMP HERETO AND MAIL TO
ACKNOWLEDGE RECEIPT OF THE ATTACHED:

G. Magnusson

APPLICANT

August 24, 2001

MAILING DATE

899 due 8/25/01

PCT/SE00/00203 application, PTO1390
in dupl., Submission of Drawings Reques
for approval of drawing corrections
Amendment ^{TYPE OF DOCUMENT(S)} A Prior to Action and sub-
mission of Red lined version, ex. Decl.
IDS, Filing Fee

P01_0292

REFERENCE NUMBER

09/914248

SCHIFF HARDIN & WAITE

JC14 Rec'd PCT/PTO 24 AUG 2001

5 BOX PCT

IN THE UNITED STATES DESIGNATED OFFICE
OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER THE PATENT COOPERATION TREATY-CHAPTER II
AMENDMENT "A" PRIOR TO ACTION AND SUBMISSION OF
SUBSTITUTE SPECIFICATION

APPLICANT: Gunnar Magnusson
ATTORNEY DOCKET NO. P01,0292
INTERNATIONAL APPLICATION NO: PCT/SE00/00203
10 INTERNATIONAL FILING DATE: February 1, 2000
INVENTION: "IMPLANTABLE TISSUE STIMULATING DEVICE"
Assistant Commissioner for Patents
Washington, D.C. 20231

15 Sir:
Applicant herewith amends the above-referenced PCT application as follows, and requests entry of the Amendment prior to examination on the merits in the United States National Examination Phase.

IN THE SPECIFICATION:

20 Please enter the substitute specification submitted herewith pursuant to 37 C.F.R. §1.125(b). A marked-up version of the substitute specification showing all changes is also submitted herewith. The substitute specification does not contain any new matter.

IN THE DRAWINGS:

25 Please amend each of Figures 1, 2, and 3 as shown on the drawing copies marked in red, attached to the Request for Approval of Drawing Changes filed simultaneously herewith.

IN THE CLAIMS:

On page 11, cancel "CLAIMS" and substitute:

--I CLAIM AS MY INVENTION:-- therefor.

Please cancel claims 1-13 and substitute the following claims therefor:

5 14. A housing for an implantable tissue stimulating device having an electrode lead with an electrode; said housing being adapted for connection to said electrode lead and said stimulating device generating a voltage between said housing and said electrode, said voltage having an electric field associated therewith, said housing comprising:

10 a first wall having a generally flat first exterior surface, said first wall being adapted to face the skin of a patient when said housing is implanted;

 a second wall having a generally flat second exterior surface; and a circumferential third wall joining said first wall and said second wall, said third wall being composed of conductive material and adapted for electrical contact with surrounding tissue when said housing is implanted to serve as an electrode, said third circumferential wall having a curved first circumferential wall section connected to said first wall and a curved second circumferential wall section connected to said second wall,

15 said first circumferential wall section having a radius of curvature smaller than a radius of curvature of said second wall section, for curve radii in planes substantially perpendicular to said first surface and said second surface, causing said electric field to have a lower field strength along said second circumferential wall section than along said first circumferential wall section.

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15. A housing as claimed in claim 14 wherein said first wall is composed of conductive material and is adapted to be an electrical contact with surrounding tissue for serving as an electrode in combination with the electrode formed by said third wall.

5 16. A housing as claimed in claim 14 wherein said second wall is composed of conductive material and is adapted to be an electrical contact with surrounding tissue for serving as an electrode in combination with the electrode formed by said third wall.

10 17. A housing as claimed in claim 14 wherein each of said first circumferential wall section and said second circumferential wall section is circularly curved in said planes.

15 18. A housing as claimed in claim 17 wherein said first circumferential wall section has a center of curvature along a continuous first curve, and wherein said second circumferential wall section has a center of curvature along a continuous second curve.

19. A housing as claimed in claim 18 wherein said first curve and said second curve are substantially parallel.

20 20. A housing as claimed in claim 14 wherein the respective curve radii of said first circumferential wall section and said second circumferential wall section in said planes is in a range between 1:2 and 1:6.

21. A housing as claimed in claim 20 wherein said ratio is approximately 1:4.

22. A housing as claimed in claim 14 wherein said first surface is rough.

23. A housing as claimed in claim 14 wherein said first surface is contoured.

5 24. A housing as claimed in claim 23 wherein said first surface has a plurality of exterior ridges.

25. A housing as claimed in claim 24 wherein each of said ridges has at least one edge with a sharp corner.

10 26. A housing as claimed in claim 14 wherein said second surface is polished.

IN THE ABSTRACT:

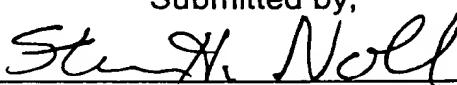
Please add an Abstract as shown on separately numbered page 14 attached hereto.

REMARKS:

The present Amendment makes changes editorial revisions in the specification, drawing, and claims, and adds an Abstract to conform to the present PCT application to the requirements of United States patent practice.

5 The claims submitted herein are considered to have the same scope as original claims 1-13, and no change in any claim has been made for the purpose of distinguishing a claim over the teachings of the prior art of record. Moreover, none of claims submitted herein is considered to narrow any of the original claims.

10 Early consideration on the merits is respectfully requested.

Submitted by,


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20 Attorneys for Applicant.

(Reg. 28,982)

ABSTRACT OF THE DISCLOSURE

A housing for an implantable tissue stimulating device is connectable to an electrode lead having an electrode. A portion of the housing also functions as an electrode. The walls of the housing are shaped so that when 5 a voltage is applied between the electrode at the electrode lead, and the housing electrode, the electric field associated with the voltage has a low field strength in regions at which unwanted stimulation of muscles can occur.